#11
RAWB

Docket No. RSW990108

PATENT 8-20-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Ims et al.** §

Serial No. **09/442,791** §

Filed: **November 18, 1999** §

For: **Legacy Host System Hot Link Modeling and Navigation** §

§ Group Art Unit: **2157**

§ Examiner: **Najjar, Saleh**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Certificate of Mailing Under 37 C.F.R. § 1.8(a)
I hereby certify this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 30, 2004.

By: Amy Miller
Amy Miller

APPELLANT'S BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on June 7, 2004.

The fees required under § 1.17(c), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. 1.192(a))

08/04/2004 EAREGAY1 00000003 090461 09442791

01 FC:1402 330.00 DA

REAL PARTIES IN INTEREST

The real party in interest in this appeal is the following party:

International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 2, 9, 13, 20, 24, 31, and 35
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37
4. Claims allowed: NONE
5. Claims rejected: 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37

C. CLAIMS ON APPEAL

The claims on appeal are: 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37

STATUS OF AMENDMENTS

All of the amendments to the claims have been entered. No after final amendments were made in this case.

SUMMARY OF INVENTION

The present invention provides a method and apparatus for navigating screens in a legacy host system. In a preferred embodiment, requests for specific legacy host screens are received by a server. The server then navigates to the appropriate screen within the legacy host system and retrieves the host screen. If there are intermediate screens which need to be navigated to get to the host screen, the server does so, but does not send these intermediate screens to the user if not needed by the user, thus saving bandwidth and time for the user. If variable data need be entered to access the host screen, the server sends the user a submittable form on which to enter the appropriate information, which, once entered and sent to the server, is used by the server to retrieve the host screen. Once the host screen has been retrieved, the server formats it into a web page format using a hypertext language such as extensible markup language (XML) or hypertext markup language (HTML) and sends the screen to the user. Selectable links are displayed to the user to allow the user to request other screens within the legacy host system. (*see Specification, page 4, lines 2-15*).

ISSUES

The issues on appeal are:

1. Whether claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37 are obvious under 35 U.S.C. § 103(a) as being unpatentable over *Himmel* (U.S. Patent No. 6,167,441) and further in view of *Tada* (U.S. Patent No. 6,237,040).

GROUPING OF CLAIMS

The claims do not stand or fall together as a single group. The claims stand or fall based on the following grouping of claims:

Group A: claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, and 32-33

Group B: claims 34, 36, and 37

ARGUMENT

I. Rejection of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37 under 35 U.S.C. § 103

The examiner has rejected claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37 under 35 U.S.C. § 103(a) as being unpatentable over *Himmel* (U.S. Patent No. 6,167,441) further in view of *Tada* (U.S. Patent No. 6,237,040).

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). For an invention to be prima facie obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Group A, claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, and 32-33

This rejection is traversed by showing that the examiner is using an improper hindsight analysis in rejecting the claims. As stated by the Federal Circuit, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight

based on the invention to defeat patentability of the invention, this court requires the examiner show a motivation to combine the references that creates the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998). "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *See In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

Applicants submit that the claims in Group A have been erroneously rejected by an improper combination of the cited references. With regard to claim 1, the examiner states:

> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmel in view of Tada so that non-HTML files are accessed by a mobile device. One would be motivated to do so to allow accessing of FTP sites and e-mail sites.

(*Office Action* dated March 10, 2004, pages 2-3). The examiner further states:

> In this case, the Himmel reference is directed toward accessing WEB pages on the Internet including FTP sites, dynamic HTML, XML, Java, etc via wireless devices. (see col. 1). Tada is directed toward accessing HTML and non-HTML files on the Internet including SMTP sites via wireless devices (see col. 1). For these reasons the combination of the references are proper.

(*Advisory Action* dated May 14, 2004). Appellant respectfully disagrees. The above statements made by the examiner argue that because *Himmel* relates to accessing Web pages on the Internet and *Tada* relates to accessing HTML/non-HTML files on the Internet, these references are properly combinable. This is clearly improper reasoning. The examiner is essentially stating that a reference that generally teaches accessing Internet content could be combined with any other reference that teaches accessing Internet content, regardless of the problems identified and solved in the different references. When each reference is considered as a whole, however, one of ordinary skill in the art would not combine *Himmel* with *Tada*, considering the problems recognized and solved. *Himmel* is directed towards providing customized Internet content to a

requesting client device using an intercepting agent. When a client device requests a file from a web server, the agent, typically located at the web server receiving the client request, intercepts the request. The agent then detects client device capability information about the requesting client device, such as display or memory capabilities. The client request is redirected to a Uniform Resource Locator (URL) according to the detected client device capability information to retrieve a version of the requested file. (*Himmel*, col. 2, lines 25-35). Thus, the *Himmel* agent addresses customizing of the presentation of a requested web page for a particular client.

In contrast, *Tada* is directed towards enabling the automatic processing of non-HTML data (e.g., email data) even if a user terminal has only a browser that handles HTML files. (*Tada*, col. 1, lines 46-49). An HTML file is requested using the WWW browser on a user terminal apparatus. An Internet connection service provider apparatus (Internet Service Provider) using the HTML file request as a trigger automatically acquires a user's e-mail and then converts the e-mail to HTML format for storage. If e-mail is present, a markup tag to the e-mail list is added to the requested HTML file and transmitted to the user terminal apparatus. When the user selects this tag, the Internet connection service provider apparatus retrieves the corresponding e-mail HTML file and returns it to the user. (*Tada*, Abstract). Thus, *Tada* provides deferred access to non-HTML data by allowing a link to email data that was converted to HTML format on the requested HTML file. The user must select this link to access the converted data. (*Tada*, Figures 11A-11D; col. 6, lines 43-67).

In view of the above, there is no motivation to combine the teachings of *Himmel* with *Tada* in the manner alleged by the examiner. *Himmel* is directed toward redirecting client web requests to client-tailored web pages. The reformatting agent in *Himmel* merely teaches customizing the presentation of the web page. There is no need, let alone any suggestion, to convert non-markup language to a markup language to customize the presentation of a selected web page in *Himmel*.

Moreover, there is no suggestion in *Tada* of a need to integrate the *Tada* system with a web page customization system, such as that taught by *Himmel*. *Tada* has nothing to do with detecting the capabilities of a client device and customizing a web page according to the capabilities of the client device. *Tada* is concerned with providing a means to enable the automatic processing of non-HTML data (e.g., email data), regardless of whether the data to be processed is requested by the user (*Tada*, col. 1, lines 40-43). When a user requests a web page,

Himmel provides the user an immediate response with a customized version of the requested data. Data which is converted from non-markup language to markup language in *Tada* is provided to the user in a deferred manner, wherein the converted data is provided to the user via a link which the user must select to access the data. There is no need, let alone any suggestion in *Tada* to provide a client-tailored web page of the requested data to match the client's capabilities. The alleged motivation offered by the examiner is not based on the actual teaching of the references. Thus, claim 1 is shown to not be obvious in view of the cited references, per *In re Beattie,* supra.

Furthermore, as noted above, there is no teaching or suggestion in the references as to the desirability of including the features from the other references. As the examiner has failed to demonstrate any motivation or incentive in the prior art to combine and modify the references so as to achieve the claimed invention, the alleged combination can only be the result of impermissible hindsight reconstruction using applicant's own disclosure as a guide. As the present rejection is based completely on hindsight to the exclusion of what can be properly gleaned from the references by one of ordinary skill in the art, the rejection is improper and should be withdrawn.

Moreover, neither *Himmel* nor *Tada* teach the problem of the present invention or its source. The present invention recognizes the problem of accessing and navigating through various screens of a legacy host system without requiring knowledge of service specific commands. These legacy systems to which users desire access must be reformatted such that they are readable and useable by web browsers. However, even with reformatting, a user may be required to be familiar with the particular commands necessary to navigate through the various screens contained within a legacy host system. The present invention allows for navigating through multiple "screens" of a legacy application on behalf of a user without user intervention. For example, a user may make a request (such as clicking on a hyperlink) and a complete navigation sequence may be executed, from which the final screen is presented to the user. Thus, the present invention provides for formatting the legacy host screen from a nonmarkup language to a markup language in order to allow a user, without knowledge of system specific commands, to access and navigate the legacy system. Thus, one of ordinary skill in the art would not be motivated to modify *Himmel* and *Tada* in the manner required to form the solution discussed in the claimed invention when the problems addressed by the two references are reviewed when

considering each reference as a whole.

Claims 3-8 and 10 are dependent claims depending from independent claim 1. Claims 14-19 and 21 are dependent claims depending from independent claim 12. Claims 25-30 and 32-33 are dependent claims depending upon independent claim 23. Applicants respectfully submit that claims 3-8, 10-11, 14-19, 21-22, 25-30, and 32-33 are also patentable over *Himmel* and *Tada*, at least by virtue of their dependency on an allowable claim.

In view of the above, applicant respectfully requests withdrawal of the rejection of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, and 32-33 under 35 U.S.C. §103.

Group B, claims 34, 36, and 37

These claims are also patentable over the cited references because one of ordinary skill in the art would not be motivated to modify *Himmel* and *Tada* in the manner required to form the solution discussed in the claimed invention when the problems addressed by the two references are reviewed when considering each reference as a whole, as shown above. In addition, these claims include other patentable features from those in the claims in Group A. Independent claim 34 of the present invention reads as follows:

> 34. A macro bean for providing navigation between screens within a legacy host system, the macro bean comprising:
>
> first instructions for receiving a request for a requested host screen from a legacy host system;
>
> second instructions for determining the current host screen; and
>
> third instructions for navigating to the requested host screen, wherein intermediate host screens between the current host screen and the requested host screen are unsent to a client;
>
> fourth instructions for formatting the host screen into a formatted host screen from a non-markup language to a markup language, wherein the formatted host screen displays selectable links to other screens within host system; and
>
> sending the formatted host screen to the client.

The arguments made with respect to Group A claims apply to the claims in Group B as well. As mentioned previously, *Himmel* and *Tada* are not properly combinable when each reference is considered as a whole.

Furthermore, with regard to independent claim 34, *Himmel* and *Tada* fail to teach or suggest all elements of the claim. Independent claim 34 recites the additional feature of having a

macro bean provide navigation between screens within a legacy host system. Neither *Himmel* nor *Tada* teach this feature. The examiner does not even refer to any section of *Himmel* or *Tada* as teaching the use of a macro bean. In fact, there is no mention in either *Himmel* or *Tada* of employing a macro bean, let alone using a macro bean to navigate to a host, format the host screen, or send the host screen to the client. Thus, *Himmel* and *Tada* fail to teach having a macro bean provide navigation between screens within a legacy host system, as recited in claim 34 of the present invention.

Claims 36 and 37 are dependent claims depending from independent claim 34. Applicants respectfully submit that claims 36 and 37 are also patentable over *Himmel* and *Tada*, at least by virtue of their dependency on an allowable claim.

In view of the above, applicant submits that claims 34, 36, and 37 are not obvious in view of the *Himmel* and *Tada* references.

CONCLUSION

In view of the comments above, it is respectfully urged that the rejection of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, and 36-37 not be sustained.

Cathrine K. Kinslow
Reg. No. 51,886
YEE & ASSOCIATES, P.C.
PO Box 802333
Dallas, TX 75380
(972) 367-2001
Attorney for Applicants

APPENDIX OF CLAIMS

The text of the claims involved in the appeal are:

1. A method in a data processing system for navigating screens in a legacy host system, comprising the steps of:

receiving, from a client, a request for a host screen;

navigating to the host screen;

retrieving the host screen;

formatting the host screen into a formatted host screen from a non-markup language to a markup language, wherein the formatted host screen displays selectable links to other screens within host system; and

sending the formatted host screen to the client.

3. The method as recited in claim 1, wherein the step of navigating to the host screen comprises retrieving at least one intermediate screen in order to retrieve the host screen.

4. The method as recited in claim 1, further comprising:

responsive to a determination that variable data is needed to navigate to the host screen, sending to the client a submittable form containing text fields that may be filled in by a user; and

responsive to receiving the variable data from the client, using the variable data to retrieve the host screen.

5. The method as recited in claim 1, wherein the client is a portable data processing system.

6. The method as recited in claim 5, wherein the portable data processing system is a wireless system.

7. The method as recited in claim 3, wherein the intermediate screen is not presented to the user.

8. The method as recited in claim 3, wherein appropriate entries are made in the at least one intermediate screen in order to navigate to the host screen.

10. The method as recited in claim 1, wherein the markup language is an extensible markup language.

11. The method as recited in claim 1, wherein the markup language is a hypertext markup language.

12. A computer program product in computer readable media for use in a data processing system for navigating screens in a legacy host system, the computer program product comprising:

first instructions for receiving, from a client, a request for a host screen;

second instructions for navigating to the host screen;

third instructions for retrieving the host screen;

fourth instructions for formatting the host screen into a formatted host screen from a non-markup language to a markup language, wherein the formatted host screen displays selectable links to other screens within a host system; and

fifth instructions for sending the formatted host screen to the client.

14. The computer program product as recited in claim 12, wherein the step of navigating to the host screen comprises retrieving at least one intermediate screen in order to retrieve the host screen.

15. The computer program product as recited in claim 12, further comprising:

sixth instructions, responsive to a determination that variable data is needed to navigate to the host screen, for sending to the client a submittable form containing text fields that may be filled in by a user; and

seventh instructions, responsive to receiving the variable data from the client, for using the variable data to retrieve the host screen.

16. The computer program product as recited in claim 12, wherein the client is a portable data processing system.

17. The computer program product as recited in claim 16, wherein the portable data processing system is a wireless system.

18. The computer program product as recited in claim 14, wherein the intermediate screen is not presented to the user.

19. The computer program product as recited in claim 14, wherein appropriate entries are made in the at least one intermediate screen in order to navigate to the host screen.

21. The computer program product as recited in claim 12, wherein the markup language is an extensible markup language.

22. The computer program product as recited in claim 12, wherein the markup language is a hypertext markup language.

23. A system for navigating screens in a legacy host system, comprising:

means for receiving, from a client, a request for a host screen;

means for navigating to the host screen;

means for retrieving the host screen;

means for formatting the host screen into a formatted host screen from a non-markup language into a markup language, wherein the formatted host screen displays selectable links to other screens within a host system; and

means for sending the formatted host screen to the client.

25. The system as recited in claim 23, wherein the step of navigating to the host screen comprises retrieving at least one intermediate screen in order to retrieve the host screen.

26. The system as recited in claim 23, further comprising:

means, responsive to a determination that variable data is needed to navigate to the host screen, for sending to the client a submittable form containing text fields that may be filled in by a user; and

means, responsive to receiving the variable data from the client, for using the variable data to retrieve the host screen.

27. The system as recited in claim 23, wherein the client is a portable data processing system.

28. The system as recited in claim 27, wherein the portable data processing system is a wireless system.

29. The system as recited in claim 25, wherein the intermediate screen is not presented to the user.

30. The system as recited in claim 25, wherein appropriate entries are made in the at least one intermediate screen in order to navigate to the host screen.

32. The system as recited in claim 23, wherein the markup language is an extensible markup language.

33. The system as recited in claim 23, wherein the markup language is a hypertext markup language.

34. A macro bean for providing navigation between screens within a legacy host system, the macro bean comprising:

first instructions for receiving a request for a requested host screen from a legacy host system;

second instructions for determining the current host screen; and

third instructions for navigating to the requested host screen, wherein intermediate host screens between the current host screen and the requested host screen are unsent to a client;

fourth instructions for formatting the host screen into a formatted host screen from a non-markup language to a markup language, wherein the formatted host screen displays selectable links to other screens within host system; and

sending the formatted host screen to the client.

36. The macro bean as recited in claim 34, further comprising fifth instructions for entering appropriate data at intermediate host screens in order to access the requested host screen.

37. The macro bean as recited in claim 34, wherein variable data received from a client is entered appropriately into one or more of the intermediate host screens.